

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

JOINT APPENDIX

IN THE
United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

268

No. 21554

EDWARD J. BRENNER, Commissioner of Patents,
APPELLANT

v.

THE STATE OF ISRAEL, Ministry of Defence, APPELLEE

APPEAL FROM THE UNITED STATES DISTRICT
COURT FOR THE DISTRICT OF COLUMBIA

United States Court of Appeals
for the District of Columbia Circuit

FILED FEB 1 1968

Nathan J. Paulson
CLERK

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DOCKET ENTRIES

Date 1967	Proceedings
Jan. 23	Complaint, appearance, filed
Jan. 23	Summons, copies (3) and copies (3) of Complaint issued Ser. 1-27; D.A. ser. 1-24; Atty. Gen. ser. 1-25.
Mar. 20	Answer of deft to complaint; c/m 3-20-67; appearance of Joseph Schimmel. filed
Mar. 20	Calendared. (N) AC/N.
June 5	Motion of pltf for summary judgment; affidavit with exhibits A, B; exhibits A & B; statement; P&A; c/s 6/5/67; M.C. filed
Jun. 20	Stipulation extending to and including 7-10-67 time for deft to respond to pltf's motion for summary judgment. filed
Jul. 10	Motion of deft for summary judgment; P&A; statement; exhibits A thru D; M.C. filed
Jul. 10	Opposition of deft to pltf's motion for summary judgment; c/m 7-10. filed
Jul. 24	Memorandum of pltf in opposition to motion of deft for summary judgment; c/s 7/24/67. filed
Aug. 28	Stipulation for postponement of oral hearing on motions for summary judgment. filed
Sep. 28	Memorandum opinion granting pltf's motion for summary judgment and denying deft's motion for summary judgment. (N) Holtzoff, J.
Oct. 10	Transcript of proceedings, 9-26-67 (Rep: Joan Curtis Blair. Court's copy). filed
Oct. 11	Order granting motion of plaintiff for summary judgment and denying motion of defendant for summary judgment; authorizing defendant to re-issue Patent 3,149,702 to plaintiff on reissue application 483,622. (N) Holtzoff, J.
Nov. 29	Notice of appeal of deft from order of 10-11-67. (copy mailed to Ellsworth H. Mosher.) filed

COMPLAINT

To the Honorable Judges of the
United States District Court
for the District of Columbia:

The State of Israel, Ministry of Defence, plaintiff herein, brings this complaint against Edward J. Brenner, United States Commissioner of Patents, defendant, and alleges that:

1. The plaintiff is The State of Israel, Ministry of Defence, the address of which is Hakirya, Tel Aviv, Israel.

2. The defendant, Edward J. Brenner, is United States Commissioner of Patents, and is officially a resident of Washington, in the District of Columbia, within the jurisdiction of this Court.

3. This Court has jurisdiction of this action under the provisions of the Patent Act, Title 35, United States Code, Section 145.

4. On November 26, 1962, a patent application, Serial No. 239,996, was filed in the name of the inventor, Jakhin Boas Popper, and concurrently with the filing of this application there was duly filed and recorded on the assignment records of the Patent Office on Reel 1207, Frame 386, an assignment from Jakhin Boas Popper to plaintiff, of the entire right, title and interest in and to the said application and any reissue applications, original patents, and reissued patents for the improvements disclosed in this application.

5. At the time of filing the said patent application Serial No. 239,996, the Patent Office was notified in a letter of transmittal that the application corresponded to Israel patent application No. 16,378, dated November 26, 1961, and the oath of the application also stated that the said Israel patent application No. 16,378 had been filed on November 26, 1961, for the same invention.

6. The application Serial No. 239,996 was found allowable; on August 3, 1964, the Final Fee was paid in the application, and on September 22, 1964, patent No. 3,149,702 was granted to plaintiff as assignee of the inventor Popper.

7. Plaintiff and the inventor Popper had a right to claim the priority benefit of the filing date of Israel patent application No. 16,378 in the said United States application Serial No. 239,996 and in the United States patent which issued therefrom; however, through error, without any deceptive intention, a claim to the Israel application filing date was not formalized, and a certified copy of the Israel application was not filed, prior to the grant of the patent No. 3,149,702. As a consequence, the patent does not contain the claim of priority.

8. Through error, without any deceptive intention, patent No. 3,149,702 is deemed wholly or partly inoperative by reason of the patent specification not containing notice of a claim to the benefit of the filing date of the Israel patent application and by reason of the patentee not having formally claimed the benefit of the filing date of the Israel patent application.

9. On October 8, 1964, a formal claim for the priority of the Israel application and a certified copy of the Israel application were filed in the Patent Office, together with a request for a Certificate of Correction in patent No. 3,149,702. The request for Certificate of Correction was denied insofar as the claim for priority was concerned.

10. On August 30, 1965, reissue application Serial No. 483,622 was filed in the Patent Office for the purpose of establishing the patentee's claim to the priority benefits of Israel application No. 16,378 and for the purpose of adding the following claim of priority to the patent specification:

"Claims priority, application Israel, November 26, 1961, No. 16378."

Plaintiff is the assignee and present owner of the entire right, title and interest in and to this reissue application.

11. In a decision dated October 31, 1966, the United States Patent Office Board of Appeals affirmed the Examiner's rejection of reissue application Serial No. 483,622, and on December 23, 1966, a Petition for Rehearing and Reconsideration was denied.

12. The decision by the United States Patent Office Board of Appeals as described in paragraph 11 hereof is in error and has prevented the plaintiff from obtaining the reissued patent to which plaintiff is entitled.

13. The decision by the Patent Office Board of Appeals as described in paragraph 11 hereof is contrary to Title 35, United States Code, Sections 119 and 251;

is without legal foundation; and is arbitrary, unfair, inequitable and unjust.

14. No appeal has been taken to the United States Court of Customs and Patent Appeals from the decision by the Patent Office Board of Appeals described in paragraph 11 hereof.

WHEREFORE, plaintiff asks for a judgment in its favor and, accordingly, prays as follows:

A. That this Court adjudge that plaintiff has complied with the requirements of the law, is entitled to the benefit of the November 26, 1961, filing date of Israel patent application No. 16,378, and is entitled to receive a reissued patent from its reissue patent application Serial No. 483,622, filed August 30, 1965.

B. That the defendant be authorized to issue such reissued patent to plaintiff.

Respectfully,

THE STATE OF ISRAEL; MINISTRY OF DEFENCE

/s/ Ellsworth H. Mosher

ELLSWORTH H. MOSHER

300 Munsey Building

Washington, D.C. 20004

Attorney for Plaintiff

[Jan. 23, 1967]

* * * *

ANSWER TO COMPLAINT

To the Honorable the Judges of the United States
District Court for the District of Columbia

1-7. Defendant admits the allegations of these paragraphs of the complaint.

8. Defendant admits that plaintiff made allegations in application Serial No. 483,622, identified in paragraph 10 of the complaint, analogous to those made in this paragraph of the complaint, but, for reasons hereinafter given, defendant denies said allegations.

9. Defendant admits the allegations of this paragraph of the complaint.

10. Defendant admits the allegations of this paragraph of the complaint, upon information and belief.

11. Defendant admits the allegations of this paragraph of the complaint.

12, 13. Defendant denies the allegations of these paragraphs of the complaint, for reasons hereinafter given.

14. Defendant admits the allegations of this paragraph of the complaint.

FURTHER ANSWERING, defendant denies that plaintiff is entitled to receive a reissued patent from its reissue patent application Serial No. 483,622, as requested in the prayers of the complaint, because a reissue patent is not grantable under the law, for the reasons given by the examiner in the Examiner's Answer, and by the Board of Appeals in its decisions in

said application. Profert of said answer and decisions
is hereby made.

Respectfully submitted,

/s/ Joseph Schimmel
Solicitor, United States
Patent Office
Attorney for the Defendant

March 20, 1967.

* * * *

PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT

Plaintiff moves this Court to enter, pursuant to Rule 56 of the Federal Rules of Civil Procedure, a summary judgment in plaintiff's favor adjudging the plaintiff entitled to receive and authorizing the defendant to issue a reissued patent from the plaintiff's reissue patent application Serial No. 483,622 filed August 30, 1965 on the ground that there is no genuine issue as to any material fact and that plaintiff is entitled to judgment as a matter of law.

This motion is based upon the following, in addition to the pleadings in this action:

- a. The annexed affidavit of Thomas E. Smith and the exhibits to that affidavit.
- b. A certified copy of the file wrapper and contents of plaintiff's reissue patent application Serial No. 483,622 filed August 30, 1965.
- c. A certified copy of original patent No. 3,149,702.
- d. A statement of material facts as to which there is no issue.
- e. A memorandum of points and authorities.

Respectfully,

THE STATE OF ISRAEL;
MINISTRY OF DEFENCE

By /s/ Ellsworth H. Mosher
ELLSWORTH H. MOSHER
300 Munsey Building
Washington, D.C. 20004
Attorney for Plaintiff

[June 5, 1967]

* * * *

AFFIDAVIT OF THOMAS E. SMITH

STATE OF ILLINOIS)
) SS:
COUNTY OF COOK)

THOMAS E. SMITH, being duly sworn, deposes and says:

1. That he is a partner in the firm of Pendleton, Neuman, Seibold & Williams, attorneys for the plaintiff in the present action and attorneys of record in United States patent application of Jakhin Boas Popper, Serial No. 239,996, filed November 26, 1962, which application matured into patent No. 3,149,702 on September 22, 1964, and attorneys of record in the application filed August 30, 1965, Serial No. 483,622 for reissue of patent No. 3,149,702.

2. That on November 21, 1962, the said firm received from applicant's attorneys in Israel the executed application papers and the executed Deed of Assignment for the application which subsequently matured into patent No. 3,149,702. A copy of the letter of transmittal is attached hereto and made a part hereof as Exhibit A and shows that the instructions from the Israel attorneys were to claim the priority date of Israel patent application Serial No. 16378.

3. That on November 23, 1962, the said firm received the formal drawings and sent the application papers and drawings to the Patent Office with a letter of transmittal containing the following statement:

"This application corresponds to Israel patent application No. 16378 dated November 26, 1961."

A copy of this letter is attached hereto as Exhibit B.

4. That on December 10, 1962, a certified copy of the Israel patent application No. 16378 was received by affiant who acknowledged said receipt to applicant's attorneys in Israel on December 11, 1962.

5. That affiant placed the certified copy in the file of the application for handling with the response to the first Office Action, and according to affiant's established clerical procedures, a reminder notification should have been and normally would have been attached to the file for the purpose of reminding affiant that a certified copy of the foreign application was to be sent to the Patent Office when responding to the first Office Action.

6. That through a clerical error, the reminder notification was not placed in the file, and the first Office Action was answered without filing the priority document as intended and as instructed. The application was allowed and the patent subsequently issued.

7. That the failure to file the priority document was not discovered until affiant was checking the issued patent on or about October 2, 1964, and immediately upon observing the defect, affiant filed a Request for a Certificate of Correction together with the certified copy of Israel patent application No. 16378.

8. That the request for Certificate of Correction was denied insofar as the claim of priority was concerned, and following this action, on August 30, 1965, applicant filed application Serial No. 483,622 for re-issue of patent No. 3,149,702.

9. That the omission of the Israel priority date in patent No. 3,149,702 and the failure to perfect the claim to the said Israel priority date is due entirely to affiant's inadvertence and to the failure of his reminder system above described and that it occurred without any fraudulent or deceptive intention on his part.

/s/ Thomas E. Smith

SUBSCRIBED and SWORN To before me this 31st day of May, 1967.

/s/ Ruth L. Pettersen

Notary Public

My commission expires: 11-22-67

[filed June 5, 1967]

EXHIBIT A

DR. REINHOLD COHN & Co.

Patent Attorneys

Tel Aviv, 9-11, Yavne Street F. O. B. 4060

Cables: Copatent Telephone 62985

Date 19th November, 1962.

Our Ref. 18035

Messrs. Olson, Mecklenburger,
von Holst, Pendleton & Neumann,
77 West Washington Street,
Chicago 2, U.S.A.

EXPRESS
URGENT

With further reference to our letter to you of 8th
November, 1962,

Please file a Patent Application in U.S.A. as indi-
cated below.

Kindly acknowledge receipt of this letter by return
airmail and let us have the Certificate of Filing, and
your debit note in duplicate.

DR. REINHOLD COHN & Co.

By:

APPLICANT: Jakhin Boas Popper, an Israel Citizen,
of 6 Ranas Street, Kiryat Motzkin, Israel.

INVENTOR: as above

TITLE: "A SPEED LIMITING DEVICE FOR LIMITING
THE SPEED OF ROTATION OF A BODY"

PRIORITY TO BE CLAIMED: Israel Patent Application Ser. No. 16378, filed 26th November 1961, in the name of Jakhin Boas Popper.

ASSIGNMENT OF PRIORITY RIGHT(S): —

WHEN TO BE FILED: As soon as possible and before the expiry of the priority period on 26th November, 1962.

DOCUMENTS:

- A) ENCLOSED: a) Executed application documents; b) Executed Deed of Assignment.
- B) UNDER SEPARATE COVER: Copy of specification together with prints of the drawings for your files.
- C) TO FOLLOW: Formal drawings to be received from Messrs. Garrett & Campbell Ltd., London.

EXHIBIT B

November 23, 1962

Honorable Commissioner of Patents
Washington 25 D.C.

Sir:

We are enclosing, for filing, papers in the application of JAKHIN BOAS POPPER for A SPEED LIMITING DEVICE FOR LIMITING THE SPEED OF ROTATION OF A BODY, together with our check for \$30.00 to cover the filing fee. This application corresponds to Israel patent application No. 16378 dated November 26, 1961.

Respectfully,

OLSON, MECKLENBURGER, VON
HOLST, PENDLETON & NEUMAN

By

DONALD A. PETERSON

DAP LW

Enc.

Appln. papers
Check for \$30.00
Assignment
Order #638 for recording
3 sheets of drawings

STATEMENT OF MATERIAL FACTS
AS TO WHICH THERE IS NO GENUINE ISSUE

The following is a statement of material facts as to which plaintiff contends there is no genuine issue, the statement being submitted in accordance with Rule 9h of the Rules of this Court:

This is a civil action brought by the plaintiff, The State of Israel, Ministry of Defence, against the defendant, Edward J. Brenner, under Title 35 U.S.C. § 145 asking judgment that the plaintiff is entitled to receive a reissued patent from reissue patent application Serial No. 483,622 filed August 30, 1965.

On November 26, 1962 a patent application, Serial No. 239,996 was filed in the name of the inventor, Jakhin Boas Popper, and concurrently with the filing of this application, there was recorded in the Patent Office an assignment from the inventor to the plaintiff of the application and any reissue applications, original patents, and reissued patents for the improvements disclosed in that application.

Applicant's United States attorneys had been instructed by applicant's Israel attorneys to claim the priority of Israel patent application, Serial No. 16,378 filed November 26, 1961. Accordingly, the letter of transmittal from applicant's United States attorneys to the United States Patent Office enclosing the original application for filing contained the following statement:

"This application corresponds to Israel patent application No. 16,378 dated November 26, 1961."

In addition, the Oath to the original United States application stated that the said Israel patent application, No. 16,378 had been filed on November 26, 1961 for the same invention.

The certified copy of Israel patent application No. 16,378 was not received by applicant's United States attorneys until December 10, 1962. This document was placed in the file of the application for handling with the response to the first Office Action, and according to established clerical procedures of the attorney in charge of the application a reminder notification should have been and normally would have been attached to the file. Through a clerical error, the reminder notification was not placed in the file, and the first Office Action was responded to on February 21, 1961 without forwarding the copy of the Israel patent application.

The application Serial No. 239,996 was found allowable, and on August 3, 1964, the Final Fee was paid in the application with Patent No. 3,149,702 issuing from this application on September 22, 1964. The patent was granted to plaintiff as assignee of the inventor Popper.

The error on the part of applicant's United States attorneys in failing to formalize the claim to the Israel application and in failing to file a certified copy of the Israel application arose from inadvertence, accident or mistake, and it was without any fraudulent or deceptive intention on the part of either applicant or his attorneys. As a result of this error, patent No. 3,149,702 does not contain a claim to the priority

benefit of the filing date of Israel patent application No. 16,378, and the said patent is, therefore, deemed solely or partly inoperative. The error was not discovered until after the patent issued.

On October 8, 1964 a formal claim for the priority of the Israel patent application and a certified copy of the Israel patent application were filed in the United States Patent Office together with a Request for a Certificate of Correction in patent No. 3,149,702. The Request for a Certificate of Correction was denied insofar as the claim for priority was concerned.

On August 30, 1965 reissue application Serial No. 483,622 was filed in the United States Patent Office for the purpose of establishing the patentee's claim to the priority benefits of Israel patent application No. 16,378 and for the purpose of adding the following claim of priority to the specification:

"Claims priority, application Israel, November 26, 1961, No. 16,378."

Plaintiff is the assignee and present owner of the entire right, title and interest in and to this reissue application.

The reissue application, Serial No. 483,622, stands rejected as a result of the United States Patent Office Board of Appeals' decision dated October 31, 1966, and its denial of a petition for rehearing and reconsideration on December 23, 1966.

Respectfully,

THE STATE OF ISRAEL; MINISTRY OF DEFENCE

By /s/ Ellsworth H. Mosher
ELLSWORTH H. MOSHER
300 Munsey Building
Washington, D.C. 20004
Attorney for Plaintiff

[June 5, 1967]

* * * *

DECISION BY BOARD OF APPEALS

Ex parte JAKHIN BOAS POPPER

Application for Patent filed August 30, 1965, Serial No. 483,622, for Reissue of Patent No. 3,149,702 Granted September 22, 1964. Device for Limiting the Speed of Rotation of a Body.

Pendleton, Neuman, Seibold and Williams for appellant.

Before Dracopoulos and Bailey, Examiners-in-Chief and Bendett, Acting Examiner-in-Chief.

Bailey, Examiner-in-Chief.

In this reissue application the description of the subject matter claimed, the illustration of the subject matter claimed, and the claims remain identical with the patent.

The reissue is sought for a single purpose. In the parent application the oath refers to a foreign patent. It was the intent to claim its date for priority purposes. However, clearly through inadvertence and without deceptive intention, there was failure to comply with the requirements of 35 U.S.C. 119. This fact was discovered immediately subsequent to patent issue and this reissue application was filed for the purpose of correcting this inadvertent error.

The Examiner has rejected the reissue application on the ground that the present type of error may not

be corrected under the provisions of 35 U.S.C. 251. In this connection he has cited *Ex parte* Arkless, 1958 C.D. 19, 726 O.G. 635, 116 USPQ 214.

We have considered the rejection as stated in the Answer in the light of the brief and the remarks made at the rearing, without being persuaded of any error in the rejection. We hold this opinion for the reasons advanced in *Ex parte* Arkless, *supra*, and for additional reasons that we will give below in considering appellant's arguments.

The question is entirely one of statutory construction. Questions as presented in the instant application can be considered on the basis of the statutory provisions only since the additional limitations introduced by the rules of practice would have no pertinence in connection with the instantly considered situation.

The pertinent provisions of 35 U.S.C. 119 are found in the first sentence of the second paragraph which sets up the requirements for obtaining the statutory right of priority of a foreign filing date. These provisions are:

"No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country."

It will be seen from the requirements quoted that there must be a claim made and certain certified copies of foreign papers filed *before* the patent is granted. The alternatives are of no pertinence to the situation being considered.

The file wrapper of the patent shows lack of compliance; this lack of compliance was, as we have already pointed out, through error and without deceptive intention.

This provisions of 35 U.S.C. 251 on which appellant relies as a basis for making the claim to priority in this reissue application are embraced in the following quoted portion of the first sentence of this section:

"Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reasons of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent * * *"

It will be seen as pointed out in *Ex parte* Arkless, *supra*, that the only explicit provisions pertain to (1) a defective specification or drawing (this referring to the subject matter disclosed for which appellant sought the patent) and (2) to the appellant claiming more or less than he had a right to claim (this referring to the claims of the patent to the subject matter disclosed for which the patent was issued) being too broad or too narrow.

We will now consider appellant's arguments pertinent to the noted provisions and the construction thereof that we have briefly indicated above.

This briefly indicated construction is the one stated in *Ex parte Arkless, supra*, which appellant challenges as contrary to the express statutory language and contrary to higher authorities.

In making this challenge the brief does not in fact quote the pertinent provisions of Section 119, refer to the express language, analyze the same, and show wherein *Ex parte Arkless, supra*, was in error.

The argument is based entirely on the proposition that Section 119 is among the provisions of statute to which reference is made by the third paragraph of 35 U.S.C. 251 which states:

"The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent."

The arguments presented are also based on the apparent proposition that a reissue patent is a new patent and not a corrected original patent.

It will be observed that the provisions of Section 251, by express terms contains the directive:

"... the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent."

Thus it follows that all actions taken in a reissue application are those taken after issue of the patent, although before reissue (second issue) thereof. However, section 119 states that the claim to priority must be presented (as set out in this provision) before the patent is granted.

Thus, there is express language in Section 119 which necessarily means that the right of priority may not be obtained if the claim is made and perfected subsequent to grant of the patent.

Appellant's argument on this point appears in the brief at page 7 and is based on *Union Asbestos & Rubber Co. v. Paltier Corporation*, 298 F.2d 48 (7 Cir. 1962), and particularly from the quotation taken from page 51, right column which we reproduce as it appears in the brief:

"... In our view, the references in section 251 to '* * * [P]rovisions of this title relating to applications for patent * * *' are to those sections in Chapter 11 entitled 'Application for Patent,' ..."

We do not disagree with this statement by the Court. However, we call attention to the portion of the opinion immediately following such quotation which states:

"[2] There is nothing in the 1952 Patent Code to indicate that Congress intended thereby to change the long-established view as to reissue patents, that the defective patent, although amended and corrected, is still the same patent."

Thus this decision emphasizes the point that we made above; that Section 119, by its express terms, limits the statutory right to obtain the priority of a foreign application to making and perfecting the claim prior to issue of the patent. Since a reissue application results in the mere reissue of the same patent, nothing done during prosecution of the reissue application relative to priority can meet this statutory requirement.

Appellant cites a number of decisions with which we can entirely agree. The reissue statute is remedial and should be construed as advantageously to reissue applicants as possible. However, we cannot so apply the provisions of the reissue statute as to embrace that which is not embraced by its terms and is inconsistent with the express language of Section 119. Congress is the one to set the time within which a statutory right may be exercised. This Board cannot change this aspect of Congressional discretion.

Thus we agree that the present attempt to reissue is inconsistent with the express provisions of Sections 119 and 251.

So far as we can see, the argument presented in the brief at page 9, that Section 251 would be inconsistent with Section 112 if it is inconsistent with Section 119, is a non-sequitur. Section 251 deals with disclosure in specification and drawing and with the claims identifying the subject matter for which the patent is issued. Section 112 deals with these same subjects. Section 251 states that errors without deceptive intention in disclosure or claim may be cor-

rected if such corrections introduce no new matter and if change in claim to make the same broader in scope is attempted only in a reissue application filed within the statutory time period. Thus, contrary to this argument these two sections are complementary and deal with the same subject, one from an original disclosure and claiming viewpoint, and the second from a correcting viewpoint.

Appellant's next point that appears to require comment starts on page 11 of the brief where he alleges that the Arkless case is in conflict with Benger Laboratories Ltd. v. R. K. Laros Co. et al., 209 F.Supp. 639 (D.C.E.D. Pa. 1962), aff'd per curiam 317 F.2d 455 (3 Cir. 1963), *cert. den.* 375 U.S. 833.

As this decision points out, the Benger case did not involve a claim for priority made and perfected only in the reissue. It involved a question of new matter and held that matter described in appellant's provisional British application which was identified in the original application was not new matter when added to the disclosure of the reissue application and that its omission was through error without deceptive intention. This decision refers to the Arkless case and accurately notes its non-pertinence and the only holding made when they stated at 209 F. Supp., page 645 right column:

"... The case goes no further than to say that a claim for priority cannot be validly made for the first time in an application for reissue."

The other cases cited involve no more than the general equitable principle with which we have al-

ready agreed of construing remedial statutes generously or they refer to situations of no pertinence to the question here being decided.

We will therefore affirm the Examiner's rejection of the instant reissue application on the ground that the sole basis for reissue is not consonant with the express provisions of statute, since it is not timely (the time being set by Section 119 as prior to the issue of the patent). Since this statutory requirement is inconsistent with Section 251 which deals only with acts subsequent to patent issue for the purpose of correcting and reissuing the same patent, such provisions do not cover the instant situation.

The decision of the Examiner is affirmed.

BOARD OF APPEALS

/s/ P. T. Dracopoulos
Examiner-in-Chief

/s/ M. F. Bailey
Examiner-in-Chief

/s/ Benjamin Bendett
Examiner-in-Chief
(Acting)

AFFIRMED

PENDLETON, NEUMAN, SEIBOLD
& WILLIAMS
77 West Washington St.
Chicago, Illinois

[Oct. 31, 1966, filed July 10, 1967]

OPINION OF THE DISTRICT COURT

Ellsworth H. Mosher, of Washington, D. C., and Sidney Neuman, of Chicago, Illinois, for the plaintiff.

Joseph Schimmel, Solicitor of the Patent Office, and Jere W. Sears of counsel for the Patent Office, both of Washington, D. C., for the defendant.

This is an action under the Patent Laws. It presents the question whether a reissue patent may be granted for the purpose of correcting an omission to perfect a claim to the benefit of a prior filing date of a parent application in a foreign country; specifically, whether a failure to file a certified copy of the original foreign application in due time may be cured by a later filing and whether thereafter a reissue patent may be obtained with a valid claim to the right of priority based on the foreign application. This action is brought under 35 U.S.C. § 145, to authorize the Commissioner of Patents to grant to the plaintiff a reissue patent on an application that the Commissioner has rejected. The facts are not in dispute and the matter is before the Court on cross-motions for summary judgment.

The plaintiff in this action is the State of Israel, which is the owner of rights to an invention developed in its Ministry of Defence by one of its employees, consisting of a device for limiting the speed of rotation of a body. The invention was originally patented in Israel and an application for a patent of the United States was submitted to the United States Patent

Office within a year after the filing of the original foreign application. Under these circumstances the plaintiff is entitled to the benefit of the earlier filing date, 35 U.S.C. 119. The plaintiff claims this right of priority, but because of a failure to perfect the claim due to an inadvertent omission to file a certified copy of the original foreign application before the United States patent was granted, the United States patent was issued without any notation of the right of priority. Subsequently, a certified copy of the original foreign application was filed and an application for a reissue patent was made to the United States Patent Office, solely for the purpose of making the necessary correction by awarding to the applicant the right of priority. The Patent Office denied the application on the ground that there was no authority to grant a reissue patent for the purpose of curing such an omission. Only a question of law is involved, namely, whether the statute governing reissue of patents is applicable under these circumstances and whether the plaintiff is entitled to a reissue.

The original patent application was filed in Israel on November 26, 1961, and was numbered 16,378. A year later, on November 26, 1962, an application was filed in the United States Patent Office, Serial No. 239,996. The letter of transmittal from the plaintiff's American patent attorneys to the United States Patent Office contained a statement that the American application corresponded to the application previously filed in Israel. The oath attached to the American application also stated that application No. 16,378,

had been filed in Israel on November 26, 1961, for the same invention.

The American application was allowed and United States patent No. 3,149,702 was issued on August 3, 1964. The United States patent, however, did not recite the claim for priority as of the foreign filing date. Plaintiff had failed to comply with the requirement of 35 U.S.C. § 119, that a certified copy of the original foreign application be filed in the Patent Office as a prerequisite to the grant of this right of priority. The pertinent provisions of that Section read as follows:

"No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country."

The required certified copy had been forwarded by the plaintiff to its American patent attorneys, but as a result of some oversight in the routine of their office, the certified copy was not timely filed in the Patent Office. It was filed subsequently and an application for a reissue patent was presented. The only correction requested in the reissue was the insertion of a statement that "the applicant claims priority, application Israel, November 26, 1961, No. 16,378." The Examiner rejected the application for reissue. His decision was affirmed by the Board of Appeals of the

Patent Office. It ruled that the statute authorizing reissue of patents, could not be invoked in the situation presented in this case.

The granting of reissue patents is governed by 35 U.S.C. § 251, the pertinent provisions of which read as follows:

"Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, *by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim* in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent." [Emphasis supplied.]

* * * *

"The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent."

It is apparently the view of the Patent Office that the clause in this statute permitting the grant of a reissue patent "by reason of the patentee claiming more or less than he had a right to claim in the patent" is limited to the claims defining the invention and does not extend to a claim to a right of priority on the basis of a foreign date. In the opinion of this

Court, this is too narrow a view. No reason is perceived why the word "claim" should be construed and confined to claims to the invention. Section 119 uses the term "claim" in connection with a right of priority. No basis is discernible for not interpreting the word "claim" used in Section 251 as comprizing claims of both types; claims to the invention and claims to rights of priority under Section 119. Such a construction seems reasonable. It gives full force and effect to both Sections and meets the possible contention that the two may be inconsistent. The purpose of the statute governing reissue of patents is to provide a remedy and method for correcting errors made by applicants or their attorneys. The Congressional intent should be effectuated and should not be defeated or limited by artificial restrictions. The statute is remedial and should be liberally construed, *Application of Willingham* (CCPA) 282 F. 2d 353.

It is an elementary principle of statutory interpretation that all laws should receive a sensible and reasonable construction. The reason of the law should prevail over its letter, *United States v. Kirby*, 7 Wall. 482, 486-7; *Church of the Holy Trinity v. United States*, 143 U.S. 457, 459; *Sorrells v. United States*, 287 U.S. 435, 446. In the last cited case Chief Justice Hughes stated:

"Literal interpretation of statutes at the expense of the reason of the law and producing absurd consequences or flagrant injustice has frequently been condemned."

In *Benger Laboratories, Limited v. R. K. Laros Company*, (ED-Pa.) 209 F. Supp. 639, 645, Judge Kirkpatrick expressly held that reissues are permissible for the sole purpose of perfecting a defective claim to priority. In that case the specification in the original patent had omitted an example and a drawing, which were needed to sustain such a claim. The application for a reissue sought to insert the omitted matter. A reissue was granted, and its validity was sustained by the Court.

In the light of the foregoing discussion, the Court concludes that the phrase "claim in the patent" as used in Section 251 includes a claim to a right of priority on the basis of a foreign filing date and is not limited to claims defining the invention; that a patent may be reissued for the purpose of establishing a claim to priority which was not asserted, or which was not perfected during the prosecution of the original application; and that, accordingly, the plaintiff is entitled to a reissue of its patent.

The plaintiff's motion for summary judgment is granted and the defendant's motion for summary judgment is denied.

Counsel may submit an appropriate order.

/s/ Alexander Holtzoff
United States District Judge

September 28, 1967.

TRANSCRIPT [pp. 4 and 28 through 40]

* * * *

MR. SEARS: Yes I do, Your Honor. I represent the Patent Office. May it please the Court, my name is Jere Sears.

THE COURT: The Patent Office in these cases always has a folder or a binder made up of the government papers with the references—

MR. SEARS: To Board decisions, yes, sir.

THE COURT: Yes.

MR. SEARS: Yes—a binder.

THE COURT: Do you have that?

MR. SEARS: No, Your Honor.

THE COURT: Why not?

MR. SEARS: The nature of this case is not that.

THE COURT: Oh—it is not?

MR. SEARS: It is only a question of law involved.

THE COURT: Oh, I see.

MR. SEARS: And the facts are not in dispute.

THE COURT: I see. Very well; very well.

MR. NEUMAN: If the Court please, Mr. Sears has just stated, fortunately the facts are not in dispute.

THE COURT: Now, what is before the Court?

MR. NEUMAN: What we have before the Court are two * * *

* * * *

before the Patent is granted.”

Now the remainder of that paragraph is not important here.

THE COURT: Well, I think that is not the question. The only question is: “Can you cure the failure to comply with this requirement?”

MR. SEARS: All right. Beyond that point, the Plaintiff relies upon the third paragraph of section 251 which reads in this fashion:

"The provisions of this Title relating to applications for Patent"—and then of course that includes 119—

"—shall be applicable to applications for reissue of a patent,"

with the exception which is not material here.

The Plaintiff, however, ignores the limitation upon types of corrections in issued patents which can be made under Section 251. As Your Honor appreciates, Section 251 was revamped in 1952 as part of the present Patent Act and incorporated many of the liberal rulings in effect of the Supreme Court—for instance, as to broadened claim coverage and as to errors in drawings and the like.

In recognition of that—

THE COURT: In recognition of what?

MR. SEARS: The broadened effect that the Supreme Court had on the prior reissue provisions—

THE COURT: Well, what do you mean? Would you be more specific?

MR. SEARS: In the first paragraph of 251, Your Honor, provision is made for reissue of defective patents whenever any patent is, through error and without any deceptive intent, deemed wholly or partly inoperative or invalid.

There is the cause of the trouble.

By reason of a defective specification or drawing or by reason of the patentee claiming more or less than he had a right to claim—

THE COURT: Would you inform me—you do not have to read it again—what is your point?

MR. SEARS: The point is that the flaw or the failure on the part of the plaintiff was the failure to lodge the certified priority papers in the Patent Office before the grant of the Patentee's patent.

THE COURT: Yes?

MR. NEUMAN: That failure is not covered by the first paragraph of Section 251 because priority papers have to be filed and this is not part of any specification or any claim—

THE COURT: Well, if I put my magnifying glass on the Statute I might be able to see that you are right, but I think the Supreme Court has held time and time again that every Statute must have a sensible construction in accordance with the intent of the Legislature. You know: "The letter killeth; the Spirit giveth Life."

The purpose of the reissue Statute is to give a person an opportunity to cure a mistake so that his rights will not be lost forever because he made a mistake—or because his patent solicitor made a mistake.

MR. SEARS: Yes, as pointed out by the Board in its decision: "We recognize—"

THE COURT: What decision?

MR. SEARS: The decision of the Board of Appeals recognized that 251 has been applied liberally, but the plaintiff has not cited any case—

THE COURT: What?

MR. SEARS: —in which there has been a ruling against the explicit provision of the Act such as can

be found in the second paragraph of 119, and the Patent Office takes the position that the reissuance of a patent does not create a new patent as such. It only amounts to a corrected version of an old patent for the balance of the original patent term; it is one mode of correcting a patent.

THE COURT: Just a moment—I notice here that the Examiner's reason for rejection was different from the reason given by the Board. What was the Examiner's reason for rejection?

MR. SEARS: The Examiner's rejection, Your Honor, was that this was not a proper reissue patent or reissue application. The purpose for the reissue is said—

THE COURT: What—

MR. SEARS: —What was said was not embraced by Section 251.

THE COURT: What was his reason—just a minute. What was his reason?

MR. SEARS: Well let me read you—

THE COURT: No. No. Tell me in your own words what it was. Don't read it to me.

MR. SEARS: The reason was that the defect which plaintiff seeks to correct by reissue is not embraced by Section 251.

THE COURT: Very well, but how does his ground differ from the Board's ground?

MR. SEARS: In no material respect, Your Honor.

THE COURT: The same?

MR. SEARS: It is the same.

THE COURT: But the Board has some additional grounds?

MR. SEARS: Oh yes.

THE COURT: What were the additional reasons of the Board?

MR. SEARS: The additional reasoning of the Board is really in the form of rebuttal.

THE COURT: Oh, I see. But the conclusion was the same?

MR. SEARS: The conclusion is the same.

The Board summarizes the Examiner's position at the second paragraph, page 60 of the Plaintiff's exhibit, where the Board says the Examiner has rejected the reissue application on the ground that the present type of error cannot be corrected under the provisions of 35 United States Code, 251, and in this connection there is cited the case of Ex Parte Arkless and ex Parte Arkless is a prior published Board Decision authored by the very same Board Member that authored this case.

THE COURT: Where are you reading from?

MR. SEARS: This is the second paragraph of the Board's Opinion, page 2, which—

THE COURT: Let me know what you are reading from—are you reading from the Board's Opinion?

MR. SEARS: Yes.

THE COURT: Page 2?

MR. SEARS: Yes. This is page 2 of Defendant's Exhibit "B".

THE COURT: Oh no, no. I have the file wrapper before me and I want to know what page of the Board's Opinion you are reading from.

MR. SEARS: Yes, it is page 2 of their Opinion—page 60 of the file wrapper.

THE COURT: Page 60 of the wrapper. Oh yes—very well. And what paragraph?

MR. SEARS: The second paragraph.

THE COURT: Well now, let me see if I understand your point. Is your point, Mr. Sears, that the reissue may not be granted in this case because it does not have any one of the grounds enumerated in Section 251—is that what you are saying? Is that your point?

MR. SEARS: Yes, also I would add, Your Honor, that it would also violate the express prohibition of Section 119—second paragraph.

THE COURT: No—I am not impressed with that, because the purpose of 251 is to correct any errors made in complying with the prior requirements; the only question is: May this error be corrected by re-issue?

You claim that it cannot be because it is not one of the types of errors enumerated in Section 251—is that it?

MR. SEARS: That is a secondary argument of Defendant. That is in rebuttal to Plaintiff's primary case. Defendant primarily is raising the rights in Section 119, Paragraph 2.

THE COURT: Well now, suppose—

MR. SEARS: May I elaborate on 119?

THE COURT: Suppose I hold that 251 applies; there is no inconsistency between the two and 251 permits the reissue to correct errors. Now, there is no question about it, that there was an error here in failure to comply with 119, but the question is: Is that the kind of error that may be corrected under 251?

MR. SEARS: Well we say "no", Your Honor.

THE COURT: And you say "no,"—

MR. SEARS: That is correct.

THE COURT: —and do you say "no" because 251 in its enumeration of the types of errors that may be corrected does not enumerate that particular error?

MR. SEARS: For that reason, and also because to grant plaintiff the relief he seeks here would do violence to the second paragraph of Section 119.

THE COURT: You said that before, and I do not want to hear it again. The only question is whether that is an error that may be corrected by 251—of course it would do violence to 119.

MR. SEARS: Well Your Honor, if Your Honor would indulge me for just a minute as to the reason why the second paragraph in Section 119 is important—

THE COURT: Of course every paragraph of the Patent Law is important.

MR. SEARS: Well if the House and Senate Reports concerning the second paragraph of 119 are looked to, the Congress wanted the certified priority papers on hand in the Patent Office at the time the patent was granted for whatever reason and it is pretty apparent that the interested public, that is interested in this reissue patent, should be in a position to go to our Patent Office and satisfy themselves as to just what the effective filing date was and what priority right these people are entitled to.

THE COURT: Well Mr. Sears, does not the same reasoning apply when you are enlarging or limiting a claim by reissue?

MR. SEARS: Well there is the protection of intervening rights under reissue provisions.

THE COURT: Well now, let us see if Section 251 enumerates this type of error. If it does enumerate it then it can be cured.

MR. SEARS: If it does—yes.

THE COURT: Let us see what it does enumerate.

“Whenever a patent, through error, without any deceptive intention, is deemed wholly or partly inoperative or invalid by reason of “a defective specification or drawing”—

that, of course, does not apply—

“or by reason of patentee claiming more or less than he had a right to claim in the patent”—

Now, he made a valid claim for less than he had a right to claim, did he not?

MR. SEARS: The question, Your Honor—

THE COURT: —because he did not make a valid claim for the earlier date.

MR. SEARS: Well the claim for priority need not be in the patent.

THE COURT: You mean the claim for priority is not anywhere in the claim—in the patent?

MR. SEARS: No.

THE COURT: I see.

MR. SEARS: In other words, what they seek—

THE COURT (Interposing): In other words, you would construe the words “claim in the patent”, to be claims which come at the tail end of the patent, so to speak?

MR. SEARS: Yes, as defined in Section 112, “Claims to Intervention.”

THE COURT: I want to get your position clearly.

MR. SEARS: I mean, Your Honor, the priority claim is most often made at the end of the application and that is because one of the Patent Office rules requires that the applicant identify the earliest-filed foreign application.

It is very simple, then, for the applicant to add an extra clause on why or how priority is claimed or right in the Oath, even—that is a perfectly good explicit claim for priority and yet the Oath never forms part of the patent.

THE COURT: Well now, Mr. Sears, in other words, and let me see if I understand your position clearly—

MR. SEARS: Yes.

THE COURT: —the words “Claim in the patent” as used in Section 251—

MR. SEARS: Yes.

THE COURT: —you would contend do not include the claim for priority of a patent. Is that it?

MR. SEARS: That is correct. The points are specified in section 154—

THE COURT: Well candor compels me to state that this strikes me as a very narrow construction of the Statute.

Was it not notice when the original application was filed, that the applicant claimed the earlier date? Is that not so?

MR. SEARS: May I elaborate on that, Your Honor?

THE COURT: I beg your pardon?

MR. SEARS: What the applicant did in the original application—

THE COURT: No, no—no.

MR. SEARS: Well I must disagree with that, respectfully.

THE COURT: Would you answer my question?

My question is: The Patent Office was on notice, was it not, when the original application was filed, that the applicant claimed the earlier date?

MR. SEARS: No—I must deny that.

THE COURT: Well, was that not in their letter?

MR. SEAR: What was in their letter was a statement of relationship. I will read it to Your Honor. "This application corresponds to Israel Patent No. (so and so) dated November 25 1961."

THE COURT: Well then, that put the Patent Office on notice.

MR. SEARS: It put the Patent Office on notice of a certain relationship, but there is no explicit claim here—I am not denying that there is an implied claim.

THE COURT: Is it not a fact that the Patent Office was put on notice that the applicant claimed an earlier date when they filed the original application?

It seems to me that the answer to that is "yes."

Now, they did not perfect their claim for priority, but they made it at the very beginning. They did not perfect the claim in that they failed to file a certified copy of the foreign application.

MR. SEARS: All right. Now, that leads up to the important fact where the Defendant is concerned—which is the failure to lodge the priority papers in the Patent Office—and this is a matter of some significance, the Patent Office feels. For instance, when the Patent issues without such priority papers having been lodged in the Patent Office, the public cannot ap-

prise itself of the validity of the patent and cannot make its own determination as to whether to try to claim interference through company class or anything else—in other words, there is a dearth of vital information.

* * * *

[Filed Oct. 10, 1967]

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prise itself of the validity of the patent and cannot make its own determination as to whether to try to claim interference through company class or anything else—in other words, there is a dearth of vital information.

* * * *

[Filed Oct. 10, 1967]

JUDGMENT AND ORDER

This action having been brought before the Court on cross-motions for summary judgment and the pleadings and evidence attached to the motions, together with the briefs and oral arguments of counsel having been considered by the Court, and upon the opinion of the Court duly rendered and filed by the Court on September 28, 1967, it is hereby

ORDERED, ADJUDGED AND DECREED:

1. That plaintiff's motion for summary judgment is granted and defendant's motion for summary judgment is denied for the reasons set forth in the aforesaid opinion.

2. That the defendant Commissioner of Patents is authorized to reissue Patent No. 3,149,702 to plaintiff on reissue application, Serial No. 483,622, filed August 30, 1965.

/s/ Alexander Holtzoff
Judge

DATED: Oct. 11, 1967

Approved as to form:

Attorney for Plaintiff

/s/ Joseph Schimmel
Attorney for Defendant

NOTICE OF APPEAL

Notice is hereby given that the Commissioner of Patents, defendant above named, hereby appeals to the United States Court of Appeals for the District of Columbia Circuit from the final judgment entered in this action on October 11, 1967.

/s/ Joseph Schimmel
Solicitor, U. S. Patent Office
Attorney for Defendant

November 28, 1967

BRIEF OF APPELLEE

In the
United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 21554

EDWARD J. BRENNER, Commissioner of Patents,
APPELLANT

v.

THE STATE OF ISRAEL, Ministry of Defence, APPELLEE

Appeal from the Judgment of the United States
District Court for the District of Columbia

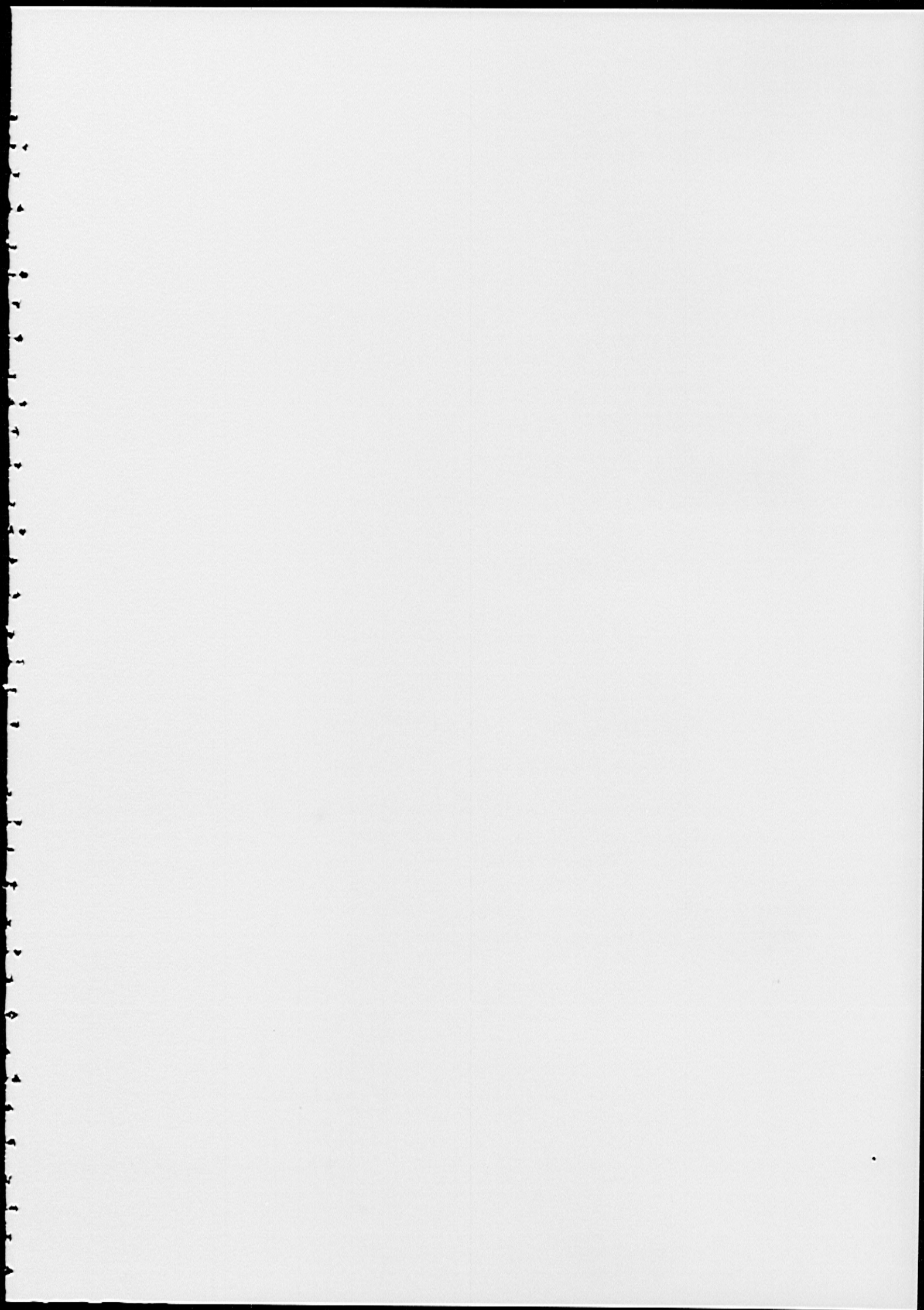
United States Court of Appeals
for the District of Columbia Circuit

FILED MAR 11 1968

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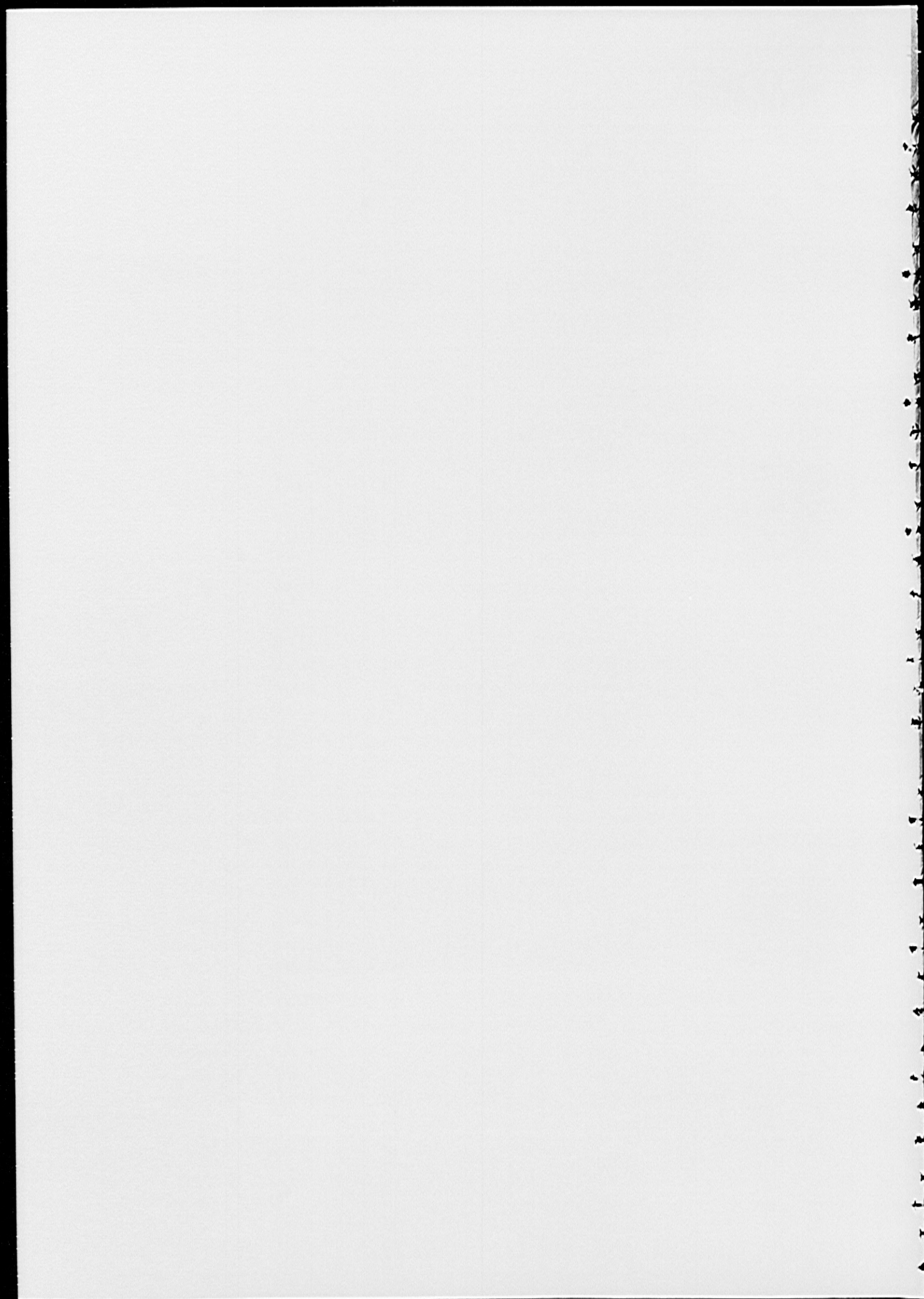
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QUESTION PRESENTED

In the opinion of appellee, the question is whether a reissue patent may be granted for the purpose of correcting an omission to perfect a claim to the benefit of a prior filing date of a parent application in a foreign country, particularly where a claim to the priority date was filed prior to the grant of the original patent and the failure of the claim is solely the result of a clerical error in failing to file the requisite certified copy of the original foreign application until after the grant of the original patent.



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CITATIONS

Cases:

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*Grant v. Raymond, 31 U.S. 218 (1832)	8, 9, 11
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* Cases or authorities chiefly relied upon are marked by asterisks.

IN THE
UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 21554

EDWARD J. BRENNER, Commissioner of Patents,
APPELLANT

v.

THE STATE OF ISRAEL, Ministry of Defence, APPELLEE

Appeal from the Judgment of the United States
District Court for the District of Columbia

BRIEF OF APPELLEE

SUMMARY OF ARGUMENT

The District Court was correct in concluding that the failure to establish a claim to the priority date of Israel patent No. 16,378 in appellee's patent No. 3,149,702 is an error which may be corrected by the remedy of reissue. Appellee had a right to claim this priority and, in fact, did claim it when the application was first filed. However, because of a clerical error, the supporting priority document was not filed and appellee's claim became a nullity. Thus, in the language of the reissue section 35 U.S.C. § 251 appellee did claim "less than he had a right to claim in the patent," and the patent specification was a "defective specification" because of the omission therefrom of

appellee's priority claim. The remedy of reissue under these circumstances is specified by the statute.

The error which caused the defect in this case was noncompliance with the technical requirements of Section 119 relating to claims of priority. Section 119 is but one of several sections of the statute relating to applications for a patent. This section does not relate to reissues and cannot be read as prohibiting reissues.

Appellant's arguments for a narrow and restrictive interpretation of the remedy of reissue in this case are not only contrary to the plain language of the statute but they show a reckless disregard for the decisional law upon which the remedy is based.

ARGUMENT

A Reissue in this Case is Permitted under the Express Terms of 35 U.S.C. § 251

The question here presented is a reissue question, pure and simple. Because of a clerical error in the office of appellee's attorneys, there was a failure to establish a claim to the priority date of Israel patent No. 16,378 in appellee's United States patent No. 3,149,702. Appellee contends, and the District Court has held, that this error can be corrected by the remedy of reissue.

Section 251 of the Patent Act (Ap. Br. 5)* relates to reissues and provides that an error committed without deceptive intention may be corrected where, as a result of the error, the patent is:

“... deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, . . .”

Appellant admits that the error in this case was committed without deceptive intention (Ap. Br. 2).

Appellant further admits that applicant (appellee) “had a right to *claim*” the priority benefit of the filing date of the Israel patent application (Ap. Br. 2). Appellant admits that there was at least an implied claim to this priority at the time the application for patent No. 3,149,702 was filed (Ap. Br. 15, JA 42).

However, the priority claim was not established in patent No. 3,149,702 because of the omission to file the

* As used herein the abbreviation Ap. Br. means Appellant's Brief and JA means Joint Appendix.

certified copy of the Israel patent application before that patent was granted. Thus, the patentee (appellee) actually did claim "less than he had a right to claim in the patent." Moreover, there is a "defective specification" because of the omission from the patent specification of the patentee's claim to the priority date of the earlier filed corresponding Israel patent application.* The present situation, therefore, falls precisely within the express language of the reissue section of the statute.

**There is No Statutory Prohibition Against
the Grant of a Reissue Patent in this Case**

Section 119 of the patent statute relates to claims of priority and states that both the claim of priority and the priority document are to be filed "before the patent is granted." This section, however, is but one of the Sections 111 through 122 which relate to and contain the requirements for patent applications. Compliance with these sections is required "before the patent is granted." Section 119 merely states what the other sections clearly imply. Section 112, for example, requires the specification to conclude with one or more claims particularly pointing out and distinctly claiming the invention, and this must be done "before the patent is granted" on peril of the patent being declared invalid by a court.

But the question is, what happens if a patentee has made an innocent mistake during the pendency of his application? For example, what happens if after the patent is granted he discovers that he has not particularly pointed out and distinctly claimed his invention as required by Section 112, or that he has not formalized or

* The priority claim, when recognized by the Patent Office, is *printed* as part of the patent specification. The *printed* copy of the specification (and drawings) is "annexed to the patent" and is "a part thereof." 35 U.S.C. §154

perfected his claim to the priority benefit of a foreign application as required by Section 119? May not the patentee, thereafter, apply for a reissue patent and cure either of these claiming defects?

The appellant would conclude that a patentee is entitled to cure one type of claiming defect but not the other. But Section 251, the reissue section, makes no distinction between the "claim" of Section 119 and the "claim" of Section 112. Both of these sections contain requirements for the period before the patent is granted, both relate to "claims," and there is no reason why violations of both may not be cured by the remedy of reissue.

Appellant seems obsessed with the idea that, since appellee's failure was noncompliance with Section 119, for that reason and that reason alone the reissue application must be refused. However, in determining the availability of the reissue remedy for rectifying a defect in a patent, whether that defect be, for example, the result of a violation of Section 112 or the result of a violation of Section 119, the answer is not to be found in a reading of the violated section. The remedy of reissue is governed only by the reissue section of the statute and by the cases dealing with reissues.

That a reissue patent may be granted for the purpose of perfecting a claim of priority in full accordance with the provisions of Section 119 also appears from the express language in the third paragraph of Section 251 which states:

"The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, . . ."

The provisions of Section 119, are "provisions . . . relating to applications for patent" and are in fact found

in Chapter 11 of the Patent Act entitled "Application for Patent."* In applying the language of Section 119 to applications for reissue (as the third paragraph of Section 251 requires), the language "before the patent is granted" is read "before the reissue patent is granted." Thus Sections 119 and 251 read together permit reissue to correct a defect in perfecting or establishing a claim to priority if the requisite steps are taken "before the reissue patent is granted," *provided*, of course, the error in failing to establish a proper claim was committed without deceptive intention.

**The Reissue Remedy Very Easily and Properly
Cures the Defect in this Case.**

Every reissue application is based upon the fact that through error without deceptive intention some provision of the statute governing patent applications was violated before the patent was granted. Reissues are intended to cure errors of the type which could have been and would have been cured by the taking of proper action during the pendency of the patent application. The remedy is to prevent the issuance of the patent from forever foreclosing the patentee from the enjoyment of his patent rights merely because the error was detected too late. A sense of fairness dictates the remedy.

Reissues operate to cure those defects by the simple mechanism of permitting the application to be reopened and the defect cured *nunc pro tunc*, so that when the patent reissues, it has, in the language of 35 U.S.C. § 252,

* This is confirmed by *Union Asbestos & Rubber Company v. Paltier Corporation*, 298 F.2d 48 (7 Cir. 1962), wherein the Court stated (p. 51):

"In our view, the references in section 251 to ' . . . [P]rovisions of this title relating to applications for patent * * * ' are to those sections in Chapter 11 entitled 'Application for Patent,' . . ."

the effect "as if the same had been originally granted in such amended form." In the present situation, appellee's reissue application would reopen the application so that the priority claim may be formalized, whereby the reissued patent will have the same effect as if the patent had been originally granted with the claim for priority properly formalized or perfected.

The remedy of reissue does not violate any other part of the statute, as appellant seems to contend; it merely provides for going back into the application stage for the curing of those errors which have occurred without deceptive intention and which might otherwise render the patent invalid or inoperative.

**The Reissue Remedy is Not to be Narrowly
Construed or Artificially Restricted**

Appellant's contention that the word "claim" has one meaning in Section 119 and something entirely different in Section 251 shows clearly that appellant would not be satisfied merely to restrict the reissue remedy to the letter of the reissue section. Appellant synthesizes other limitations which would so encumber the remedy of reissue that it would be of little or no value in accomplishing its intended purpose.

The landmark decisions on reissues show that the remedy is not to be narrowly construed. The courts have not hesitated to authorize the remedy of reissue where justified by equitable principles even when the situation was not covered by the express language of the reissue section of the statute.

The first patent statute was enacted in 1790 and did not contain any provision with regard to reissues. Nevertheless, the United States Supreme Court in 1832 upheld the validity of a reissued patent and the right of the government to grant such patents. The Court speaking

through Chief Justice Marshall in *Grant v. Raymond*, 31 U.S. 218 (1832) said (pp. 241-42):

"It is equally true that the act of congress contains no words which expressly authorise the secretary to issue a corrected patent, if the original, from some mistake or inadvertence in the patentee, should be found incompetent to secure the reward which the law intended to confer on him for his invention. The force of this objection, and of the argument founded on it is felt. If the new patent can be sustained, it must be on the general spirit and object of the law, not on its letter.

"To promote the progress of useful arts, is the interest and policy of every enlightened government. It entered into the views of the framers of our constitution, and the power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors, the exclusive right to their respective writings and discoveries,' is among those expressly given to congress. * * * *The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made; and to execute the contract fairly on the part of the United States, where the full benefit has been actually received: if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield; it receives all which it has contracted to receive. The full benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved; and for his exclusive enjoyment of it during that time the public faith is pledged. That sense of justice and of right which all feel, pleads strongly against depriving the inventor of the compensation thus solemnly promised, because he has committed an inadvertent or innocent mistake.*"*

* Emphasis added throughout.

The first reissue statute was enacted a few months after the *Grant v. Raymond* decision, but this statute did not expressly authorize the grant of a reissue patent having broader claims than the original. It did provide for a reissue patent in the event that the patentee claimed "more than he had a right to claim as new." Nevertheless, in *Topliff v. Topliff*, 145 U.S. 156 (1892), the Supreme Court held valid a reissue patent having broader claims than the original. In so holding the Court stated (p. 171):

"To hold that a patent can never be reissued for an enlarged claim would be not only to override the obvious intent of the statute, but would operate in many cases with great hardship upon the patentee. * * * *The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation.*"

The rule of the *Topliff* case was again recognized by the Supreme Court in *Keller v. Adams-Campbell Company*, 264 U.S. 314 (1924), wherein the Court stated (p. 317):

"That a reissued patent enlarging claims of the original, *although not specifically mentioned* in § 4916, Rev. Stats., is authorized by that section, when the failure to claim the larger claims justified by the actual invention was due to inadvertence, accident or mistake, is settled by the decision of this Court in *Topliff v. Topliff*, 145 U.S. 156, and other cases."

The same rule as to broadened reissues was applied in *H. W. Roos Co. v. McMillan*, 64 F.2d 568 (6 Cir. 1933), wherein the Court of Appeals for the Sixth Circuit stated (p. 569):

"The statute under which a patentee may claim a right to reissue provides: 'Whenever any patent is

inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee.' 35 USCA § 64. *This statute does not specifically authorize broadened reissues, but the courts have read into it the right to such reissues where justified by equitable principle. Keller v. Adams-Campbell Co., 264 U.S. 314, 317, 44 S.Ct. 356, 68 L. Ed. 705.*"

In still another pertinent reissue case, the Supreme Court held valid a reissue patent where the only purpose of the reissue was to correct a defective drawing, and where again the reissue statute in effect at the time did not expressly authorize such a reissue.* In *Hobbs v. Beach*, 180 U.S. 383, 394 (1901), the Supreme Court stated:

"The reissue was applied for April 9, 1891, but a few weeks after the original patent was issued, *merely to correct*, as it would seem, an obvious error in one of the drawings. Possibly the error was such as would not have impaired the patentee's rights under his original designs; but he was entitled to the full scope of his invention, and if he were dissatisfied with the drawings as they stood, and the error was purely an inadvertent one, we think it was within the jurisdiction of the Commissioner of Patents to order the patent to be reissued. *The defence is purely a technical one.* There was no attempt to enlarge the claims or to alter the specifications. There is no evidence that any one could have been prejudiced by the reissue, and we see no reason to doubt that it was applied for in good faith, and with a design only of

* 35 U.S.C. § 251 now refers to a "defective specification or drawing."

securing to the patentee what he had actually invented. To justify a reissue it is not necessary that the patent should be wholly inoperative or invalid. *It is sufficient if it fail to secure to the patentee all of that which he has invented and claimed.*"

Similar principles of equity and justice have been more recently recognized in *Application of Willingham*, 282 F. 2d 354, 355 (C.C.P.A. 1960):

"The reissue provisions of the Patent Act of 1952, like the reissue provisions of the earlier patent statutes, are remedial in nature. *They are based on fundamental principles of equity and fairness and should be so applied to the facts in any given case that justice will be done both to the patentee and to the public.*"

The Court continued by citing at length and quoting with approval the aforementioned decisions by Chief Justice Marshall in *Grant v. Raymond* and Justice Brown in *Topliff v. Topliff*, *supra*.

In the present case the failure to properly secure a claim to the right of priority places appellee's otherwise valid patent in jeopardy. All the appellee seeks is the right to which it was originally entitled; it seeks merely to make its patent viable and whole. Appellant's contention that the issuance of the patent forever bars appellee from correcting a clerical error and perfecting its claim to this right hardly seems worthy of a mature patent system or of a Patent Office cognizant of its obligation of fairness to the patentee.* As was said by United States

* The Patent Office is not completely blameless for the failure of the priority claim in this case. It is established Patent Office practice (Manual of Patent Examining Procedure § 201.14(b)) to send a reminder notice to an applicant who has claimed priority but has not perfected it by filing the certified copy. Appellant admits (Ap. Br. 15) that "the Examiner did not remind (continued next page)"

Supreme Court Justice Cardozo, when he was a judge of the Court of Appeals of New York, in *Wood v. Duff-Gordon*, 222 N.Y. 88, 91 (1917):

“The law has outgrown its primitive stage of formalism when the precise word was the sovereign talisman, and every slip was fatal. It takes a broader view to-day.”

Appellant's purely technical arguments against the remedy of reissue in this case must fail. They fly in the face of the very decisions which have carved out the remedy in the first place. Such arguments have been consistently rejected by the courts. While the remedy has never been held limited to the letter of the statute, the District Court has properly held that the present situation clearly falls within the express language of Section 251, and that the error may be cured.

**The Word “Claim” is Used in the Patent Statute
in Reference to Both Claims of Invention
and Claims of Priority, and in the Reissue
Section the Term is Not Limited to One
Particular Type of Claim**

Appellant contends that Section 251 is to be narrowly construed and that the word “claim” as used in that section pertains only to claims of invention as defined by Section 112. However, in Section 119 and in appellant's own brief (Ap. Br. 2-3) the word “claim” is used in reference to a claim of priority. Judge Holtzoff properly held that in the reissue section the word “claim” should be construed to comprise claims of both types (JA 31). Appellant has advanced no cogent reason why in Section 251 the word “claim” should be construed to exclude the

* (Continued)

appellee to file the priority papers in time.” Had such prescribed reminder been sent, the present situation would have been avoided entirely.

type of "claim" referred to in Section 119 and in appellant's own brief.

The cases cited by appellant (Ap. Br. 13) simply do not support appellant's narrow and restricted construction of the word "claim." None of these cases dealt with the construction of the word "claim" in Section 251. The case of *McCormick Harvesting Machine Co. v. Aultman*, 169 U.S. 606 (1898), dealt solely with the question of whether the Patent Office had the power to revoke, cancel or annul the claims of the original patent as a result of the application for reissue and the surrender of the original patent. In *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668 (1942), the Court dealt solely with the question of what was meant by the words "the same invention" which were then part of the reissue statute. The case of *In re Handel*, 312 F.2d 943 (C.C.P.A. 1963) dealt with the question of whether limitations could either be added to or taken from the claims in a reissue application.

Appellant's attorneys know full well that prior to the District Court decision in this case, there were no known court decisions dealing with the questions of whether the word "claim" in Section 251 includes a "claim" of the type referred to in Section 119 and whether the remedy of reissue is available in a situation such as here presented. The foregoing cases cited by appellant do not even remotely relate to the subject now before this Honorable Court.

**The Reissue Remedy is Available for the Purpose of
Curing a Defective Claim of Priority**

In *Benger Laboratories, Limited v. R. K. Laros Company*, 209 F.Supp. 639, 645 (E.D. Pa. 1962), the defendant assailed the validity of a reissue patent on the ground *inter alia* that "the purpose and policy of the law

does not allow reissues *for the sole purpose of improving a claim for priority.*" Judge Kirkpatrick rejected this argument with the statement that he did not "find any authority supporting the proposition." As Judge Holtzoff properly pointed out (JA 32), the facts in *Benger* were different from the present case,* but the case does hold that reissues are permissible for the sole *purpose* of perfecting a defective claim of priority.

According to appellant the reissue remedy may not be employed for the *purpose* of curing a defect in a claim for priority. Judge Kirkpatrick rejected this contention in *Benger* and Judge Holtzoff has rejected it in this case. In fact, the *Benger* case shows that, contrary to its present contention, appellant in this case granted reissue patent No. Re. 24,642 when the "only *purpose* in applying for the reissue" was that "of improving a claim for priority." *Benger, supra*, at 645.

The Cause of the Claim Defect and the Type of Amendment Necessary to Correct it Are Not Matters of Concern in this Case

The *purpose* of the reissue in *Benger* was the same as in this case, *i.e.*, to cure a defect in a claim for priority, but the *underlying cause* of the defect and the *type of amendment* required to correct the defect in the priority claim in *Benger* were different. Perhaps therein lies the bone of contention.

Appellant steadfastly refuses to come to grips with the fact that the *cause* of the failure of the claim is unimportant insofar as 35 U.S.C. § 251 is concerned. That section is satisfied when the patent is deemed wholly or partly

* In the *Benger* case the specification was amended by reissue to bring the disclosure into conformance with the disclosure in the priority document, the priority document itself having been filed during the pendency of the original application.

inoperative or invalid by reason of a defective specification, or by reason of the patentee claiming more or less than he had a right to claim in connection with his patent. It has already been shown that the appellee in this case is "claiming less than he had a right to claim in the patent." There is no requirement regarding the *cause* of the defect in the specification or claim. The fact that the failure to establish a proper claim to the priority right in this case resulted from the failure to file the priority document should not be a basis for refusing the remedy of a reissue.

As to the *type of amendment* permitted to cure the defect by reissue (within two years of the grant of the original patent) there is only one limitation:

"No new matter shall be introduced into the application for reissue." 35 U.S.C. § 251.

In the case of the *Benger* patent, the *type of amendment* necessary to correct the defective priority claim was an amendment to the United States disclosure bringing it into conformance with the foreign. Now it may be that this type of amendment was more "usual," more in keeping with appellant's established ideas on the curing of defects by reissue, but that is hardly reason to refuse the remedy in this case.

Whether or Not the Priority Document is Technically Part of the Patent, the Fact Remains the Priority Claim is Defective and is Curable by Reissue under the Express Provisions of Section 251

Whether the certified foreign priority papers technically form part of the "specification," or a "claim in the patent," or even part of the patent is of no consequence, appellant's tenuous argument to the contrary notwithstanding (Ap. Br. 15-16). The point is that the failure to

file such a paper in this case resulted in the omission from the patent specification of the notice of the priority claim, and what is most important, it resulted in the complete loss of effectiveness of the priority claim. The claim became a nullity, and Section 251 became applicable, for the patentee did fail to establish that claim in the patent.

The Granting of a Reissue in this Situation Would Not Unduly Impair the Assessment of Rights by the Public

In the present case a claim to priority was timely made (JA 42, Ap. Br. 15). The failure to establish the claim in the patent was solely the failure to file the priority document until two weeks after the issuance of the patent (JA 16-17). Anyone examining the file of patent No. 3,149,702 would know that the patentee was claiming priority but through an oversight, curable by reissue, the claim was not established in the patent. No one could possibly be misled.

In every reissue situation there is some degree of impairment of the public's assessment of the patentee's rights. The remedy of reissue is, in fact, applicable only to patents which are assessed "wholly or partly inoperative or invalid," the very purpose of reissue being to change this assessment. But this is hardly grounds for denying the remedy. The curing of an error to secure to the patentee that right to which all agree he was entitled in the first place can certainly not be prejudicial to anyone.

It is, perhaps, worthy of note that when appellant granted reissue patent No. Re. 24,642, which was the subject of the *Benger* case, *supra*, there was, apparently, no concern whether that might "impair assessments by the public of effective filing dates." Clearly before the reissue was granted, the "effective filing date" of the patent must have been at least doubtful.

Appellant's sudden concern for the assessment of the patentee's rights by the public is clearly an afterthought. It provides no logical or just basis for refusing to grant a reissue in this case.

CONCLUSION

Appellant has failed to show that the District Court erred in authorizing the remedy of reissue. The granting of a reissue in this situation is not only sanctioned by the express language and clear intent of the statutory provisions, it is completely in accordance with the objectives of the patent laws and the general principles of equity, fairness and justice.

The judgment of the District Court is sound and correct. It should be affirmed.

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